

REMARKS

Ms. Soward is thanked for the time extended on Thursday, March 11, 2004, to Assignee's representative, Mr. Larson, to discuss the present application. No substantive discussions were conducted; instead Ms. Soward requested that a response to the Non-Final Action be provided. This response is pursuant to that request. Examiner Soward is requested to contact Mr. Larson at the below-listed number should Ms. Soward believe that the application not be in condition for allowance.

It has been suggested by the Office that a brief summary of the invention be included within the specification. It is respectfully submitted that no Summary of the Invention section is to be provided, as allowed by the suggestive language of 37 C.F.R. § 1.77(b) requesting said summary.

Claims 14-25 are pending in the present application. Claims 14-25 have been rejected by the Office. Reconsideration of the Non-Final Office Action is requested based upon the comments herein.

Claim 24 has been amended to overcome the § 112 informality identified by the Office. Withdrawal of the rejection under § 112 of claim 24 is respectfully requested.

Claims 14-25 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Applicant's prior art figures in view of *Stearns* and *Kameda*. Claim 1 recites a semiconductor substrate having a bond pad portion and an active bus portion. The bond pad portion of the semiconductor substrate includes a first conductive trace that couples a first bond pad to a third bond pad, wherein there is a second set of bond pads immediately adjacent to both the first and third bond pads. The Office states that this is disclosed by the admitted prior art in view of *Stearns* and *Kameda*. Applicants respectfully disagree.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

For reference purposes, the Examiner's attention is directed to FIG. 6 of the application, reproduced below, wherein a specific embodiment is illustrated. The embodiment of FIG. 6 illustrates a semiconductor substrate comprising a conductive trace 189 coupling a bond pad 172 to a bond pad 174, while another bond pad 173 (second set of bond pads) is adjacent to both of the bond pads 172 and 174. The Office admits in its response, that the prior art figures of the application do not teach a conductive trace coupling the first bond pad to the third bond pad as

recited. Instead, the Office cites *Stearns* as disclosing such a conductive trace at FIG. 3 and column 5, lines 17-64. The Applicant respectfully disagrees.

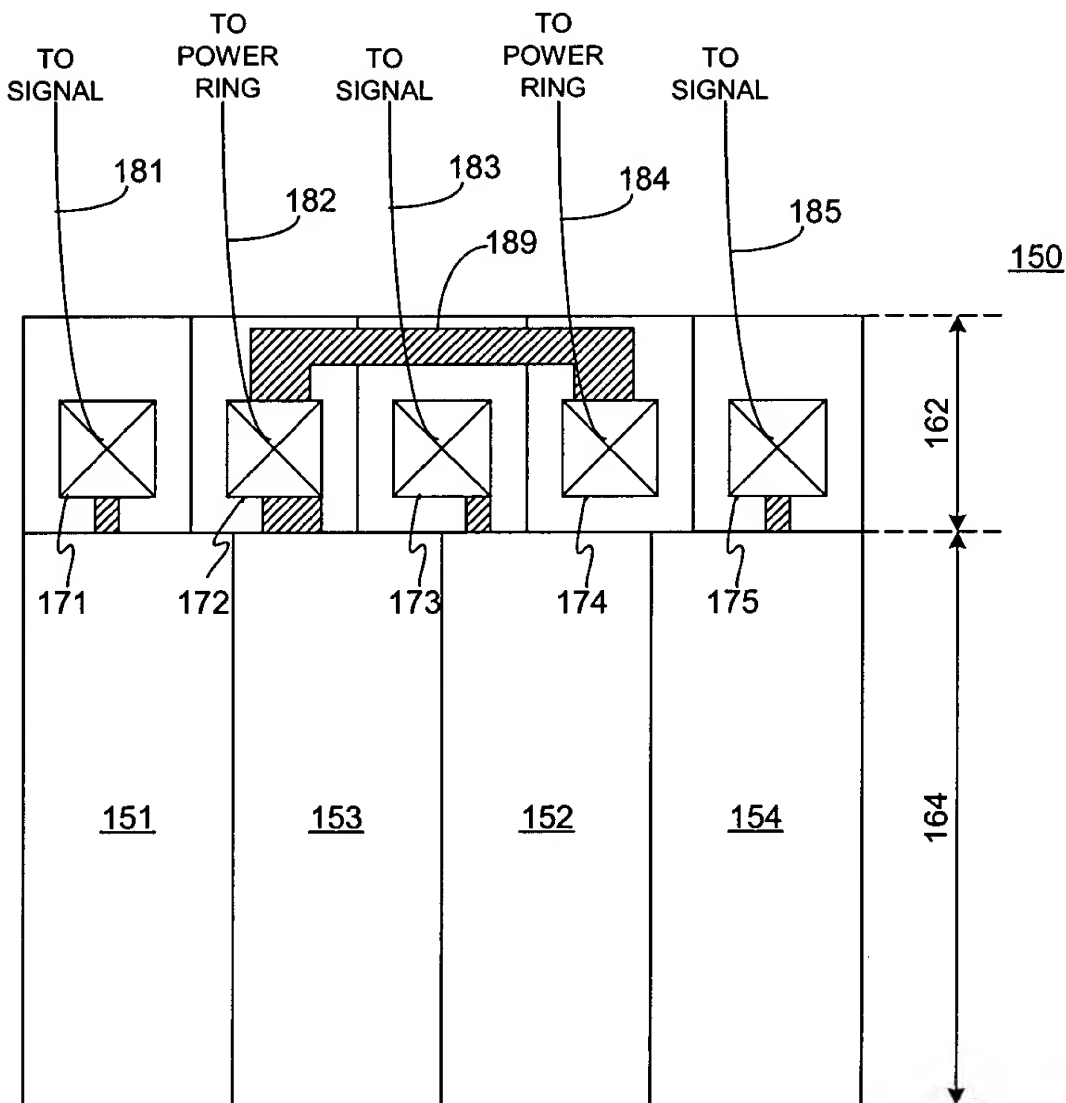


Figure 6

The disclosure of *Stearns* does not disclose a semiconductor substrate as recited. Instead, *Stearns* discloses a ball grid array package. There is no suggestion or motivation provided to modify or combine the references, absent applicants' disclosure, to arrive at the recited invention

of claim 14 specifically reciting a semiconductor substrate. Therefore, the references relied upon by the Office, neither alone nor in combination, disclose or suggest the recited elements of claim 14, nor of those claims depending from claim 14. In addition, those claims depending from claim 14 disclose additional non-obvious subject matter.


Claim 24 has also been rejected by the Office for similar reasoning as claim 14. In that claim 24 specifically is limited to a semiconductor substrate containing specific elements coupled in a specific combination, the rejection by the Office is believed improper for the reasons put forth previously. Specifically, no disclosure or suggestion is provided by the references, alone or in combination, to arrive at a semiconductor device as recited in claim 24. Absent Applicant's teaching, there would be no motivation to combine the references to arrive at the claimed invention. Therefore, the references relied upon by the Office, neither alone nor in combination, disclose or suggest the recited elements of claim 24, nor of those claims depending from claim 24. In addition, those claims depending from claim 24 disclose additional non-obvious subject matter.

Should the Examiner deem that any further action by the Applicant would be desirable for placing this application in even better condition for issue, a call to the Applicant's representative listed below is requested.

Applicant(s) does not believe that any additional fees are due, but if the Commissioner believes additional fees are due, the Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-0441.

Respectfully submitted,

3-16-04
Date


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